

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

J.T. COLBY & COMPANY, INC. d/b/a/)
 BRICKTOWER PRESS, J. BOYLSTON &)
 COMPANY, PUBLISHERS LLC and)
 IPICTUREBOOKS LLC,)
)
 Plaintiffs,)
)
 -against-)
)
 APPLE INC.,)
)
 Defendant.)

Case No. 11 Civ. 4060 (DLC)

DECLARATION OF JOHN T. COLBY, JR.
IN OPPOSITION DEFENDANT’S MOTION TO EXCLUDE ANY TESTIMONY,
ARGUMENT OR EVIDENCE REGARDING THE EXPERT REPORTS AND
OPINIONS OF SUSAN SCHWARTZ MCDONALD

I, John T. Colby, Jr., under penalty of perjury, pursuant to 28 U.S.C. § 1746, hereby declare as follows:

1. I am over 18 years old and I am competent to make this Declaration based upon my personal knowledge. I am the principal and direct or indirect owner of all Plaintiffs in this action. I make this Declaration in opposition to Defendant Apple Inc.’s (“Apple”) Motion To Exclude Any Testimony, Argument Or Evidence Regarding The Expert Reports And Opinions Of Susan Schwartz McDonald.¹

¹ Defendant’s Memorandum of Law in Support of Defendant’s Motion To Exclude Any Testimony, Argument Or Evidence Regarding The Expert Reports And Opinions Of Susan Schwartz McDonald is referenced herein as “Def. Mem.”; Defendant’s Memorandum of Law in Support of Defendant’s Motion For Summary Judgment is referenced herein as “Def. Summ. Judg. Mem.”

2. Defendant's statements that "Plaintiffs recently changed their mark from 'ibooks' (all lower case) to copy Apple's distinctive 'iBooks' formulation (lower case 'i,' capital 'B'), in an apparent effort to create confusion," Def. Summ. Judg. Mem. at 3, and that the "change [was] apparently made by Plaintiffs either to help their case in this litigation or to improperly take advantage of Apple's goodwill," Def. Mem. at 1-2, are wholly inaccurate. I was never asked at my deposition or in the course of written discovery about the reasons for the two variations—ibooks and iBooks—of the IBOOKS mark. Had I been asked, I would have responded as follows:

3. Plaintiffs own the trademark IBOOKS, whether it appear as ibooks or iBooks. From its first use in September 1999 until September 2011, the mark on physical and electronic copies of our books appeared exclusively as ibooks. The critical elements of the mark's presentation are, and have been, a lower-case "i" and no separation between the "i" and the "books" elements. For example, the lower-case "i" appears inside the light bulb that is a signature element of the IBOOKS logo as it appears on the books we publish.

4. In or around June 2011, I noticed that Amazon.com ("Amazon") had begun listing the imprint as iBooks on most, if not all, of our titles. Upon learning of the capital "B" listing, I attempted to get Amazon to list the mark as ibooks. These attempts failed. This was unsurprising, as my earlier attempts to have Amazon change numerous mistakes in their ibooks listings were also unsuccessful.

5. I made the decision to shift some but not all books into the marketplace with the capital "B" formulation based on Amazon's apparent decision to list my titles as such. I value Amazon's judgments as a major retailer. Also, with the advent of Amazon's Kindle, I felt that more people would encounter my titles on Amazon and that consistency with Amazon listings

was important. My decision to use the capital “B” formulation on certain titles was a marketing experiment, to test Amazon’s apparent preference, and was not motivated by any desire to imitate Apple.

6. Amazon has since changed the way it lists my titles from time to time. I continue to release some books using the capital “B” formulation.

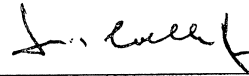
7. Plaintiffs own the IBOOKS mark no matter whether and where the letters in that sequence are capitalized. I consider both spellings (upper-case “B” and lower-case “b”) simply to be varying presentations of the same IBOOKS mark that Plaintiffs own and use.

8. Since that time, and as is our right as owner of the IBOOKS mark, Plaintiffs have been using and currently use both versions of the mark on books. **Exhibit A** hereto is a true and correct copy of some examples of both presentations in connection with print books; **Exhibit B** hereto is a true and correct copy of such examples for digital books (where the ipicturebooks name sometimes appears in addition to the ibooks/iBooks imprint name). My promotional materials still feature the “ibooks” name only with a small “b.” A true and correct copy of a representative example of ibooks marketing material is attached hereto as **Exhibit C**.

9. Increasingly, in recent years, Plaintiffs have been reproducing existing print titles as digital books and releasing new titles under the ibooks/iBooks imprint in digital-book form.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed this 25th day of January, 2013 in Shelter Island, New York.



John T. Colby Jr.